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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,172

10/25/2006

Rainer Uecker

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
170 WOOD AVENUE SOUTH
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EXAMINER

FAN, HUA

ART UNIT

PAPER NUMBER

2456

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/574,172	Applicant(s) UECKER, RAINER	
	Examiner HUA FAN	Art Unit 2456	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 August 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 17 August 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 16,21 and 23-30.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Bunjoo Jaroenchonwanit/
Supervisory Patent Examiner, Art Unit 2456

11) Applicant's arguments dated 8/10/2009 have been fully considered by the examiner but they are not persuasive. Please refer to the Final Rejection for examiner's positions. Further, In response to the applicant's arguments, applicant argues in substance

A) (on pages 4-5 with respect to objection to drawings) that objection to drawings should be overcome by the new drawing filed 8/10/2009;

B) (on page 8 with respect to claims 16, 21 and 23-27) that prior art Okada does not teach "a test message" because for the test message claimed "contents of the message elements are not also sent" and thus "the body of text within an email is not sent via a test message";

C) (on page 9 first paragraph with respect to claims 16, 21 and 23-27) that prior art Okada does not disclose "test message sent from one mail processing device to another mail processing device";

D) (on page 9, last paragraph with respect to claims 16, 21 and 23-27) that prior art Okada does not teach "evaluating a test message" or "sending an evaluation-result of a test message";

E) (on page 10, paragraphs 3-4, with respect to claims 16, 21 and 23-27) that prior art Okada does not teach "the blocking or transmission of respective ones of the message elements to a second mail processing device";

F) (on page 11 with respect to claims 16, 21 and 23-27) that prior art Okada cannot be combined with Etsuo;

G) (on page 12 with respect to claims 16, 21 and 23-27) that prior art Okada and Etsuo teach away from "the sending of test messages to a second mail processing device" and also teach away from "the use of any evaluation of test message or sending of an evaluation result by a second mail processing unit";

H) (on page 14 with respect to claims 28-30) that prior art Etsuo in view of Okada does not teach "sending of test message, sending evaluation results of test messages, transmission or block of respective ones of message elements".

As to point A), as indicated in the Objection to Drawings in the prior office action, "No new matter should be entered" in the replacement or new drawings; however, the new steps added to the new drawing is not cross-referenced in the specification, and the new set of steps does not appear to be all supported by the originally filed application. Therefore the Objection to the drawings is maintained by the examiner. Applicant is suggested to amend the specification to clearly reference to each step contained in the new drawings without introducing new matter(s).

As to point B), as cited in the prior Office action, Okada discloses a test message which only sends an subidentifier of an element ([0010], "a first communication device...adds only the title of the attachment file and then transmits the electronic mail"), where the "title of the attachment file" is a subidentifier of the message that identifies the attachment, an element of the message, but the attachment itself is not sent along with the test message. As to applicant's argument that "thus the body of text within an email is not sent via a test message" is not claimed and cannot be necessarily deduced from the claimed elements.

As to point C), Okada discloses sending a test message from a first mail processing device to a second mail processing device ([0010], "a first communication device...adds only the title of the attachment file and then transmits the electronic mail"), as cited in the prior Office action. It is to be noted that the mail processing device is not claimed to be "physically separate from any user terminals"; in addition it is the combination of Etsuo and Okada, not Etsuo or Okada alone, that teaches this claim as a whole.

As to point (D), as cited in the prior Office action, Okada discloses sending an evaluation-result of the test message from the second mail processing device to the first mail processing device ([0010], "second communication device can be constructed to demand the transmission of the content of the attachment file"; [0043], "the electronic mail handling unit 22 demands the transmission of the content of the attachment file indicated by the user, to the communication device 1 which is the transmitter of the electronic mail"). The test message was evaluated to see whether the attachment is needed. "demanding the transmission of the attachment" indicates a result of the evaluation.

As to point (E), It is to be noted that it is the combination of Etsuo and Okada, not Etsuo or Okada alone, that teaches this limitation. As cited in the prior Office action, Etsuo discloses the second mail processing device (mail server)'s evaluation result indicates transmitting the message elements, evaluated as not previously relayed to the recipient address data terminal; and blocking message elements evaluated as previously relayed to the recipient address data terminal (abstract; page 9, paragraph 4 – page 10, paragraph 1), and Okada discloses sending a test message. In addition, Okada also teaches the evaluation result indicates whether transmit "demanding transmitting attachment") or blocking (lacking such a demand).

As to point F), examiner disagrees. The system disclosed by Etsuo can be obviously modified by an ordinary skilled in the art at the time of invention to include sending a test message from the first mail processing device to the second mail processing device, as is taught by Okada. See suggestion/motivation of combination in prior Office action.

As to point G), examiner disagrees. See examiner's position in prior Office action and also see responses above. Etsuo in view of Okada teaches the claimed limitations, as has been presented by the examiner in the prior office action and responses to applicant's arguments above. It is not persuasive or even clear why Etsuo in view of Okada teach away from the claim.

As to point H), see similar responses presented above in response to applicant's arguments with respect to claims 16, 21 and 23-27, and also the prior Office action.

All objection/rejections set forth in the Final Rejection are maintained by the examiner. It is to be noted that the prosecution for this case has been closed.